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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,630	06/30/2003	Jeffrey A. Aaron	60027.5047US01/BLS 02049	1405
7590 05/17/2007 Jodi L. Hartman Hope Baldauff Hartman, LLC 1720 Peachtree Street, N.W., Suite 1010 Atlanta, GA 30309			EXAMINER CHOJNACKI, MELLISSA M	
			ART UNIT 2164	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/611,630	<b>Applicant(s)</b> AARON, JEFFREY A.	
	<b>Examiner</b> Mellissa M. Chojnacki	<b>Art Unit</b> 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, 9-15, 18-22 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 9-15, 18-22, and 24-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Remarks

1. In response to communications filed on March 5, 2007, claims 4-6, 8, 16-17, 23, and 34-35 are cancelled; claims 1, 3-4, 9, 11, 13, 15, 19, 21, 24, 26 and 33 have been amended, and no new claims have been added. Therefore, claims 1-3, 7, 9-15, 18-22, and 24-33 are still presently pending in the application.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 7, 9-15, 18-22, and 24-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is not limited to a method that runs on a medium. As such, the claim is not limited to statutory subject matter and is therefore non-statutory. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive

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material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Claims 2-3, 7, and 9-12 are rejected under 35 U.S.C. 101 because they are dependent upon rejected independent claim 1.

3. Claims 1, 13, and 24 are not statutory because they merely recite a number of computing steps without producing any concrete result displayed or stored on a computer medium (see MPEP 2106 IV.B.2.(b)).

### **Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 14 recites the limitations "determining at least one generic service" and "determining the at least one offered service", which renders the output of the claims vague and indefinite because it is unclear as to what would

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happen if the "generic service " was not related to the keyword? Correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 12-17, 22-28 and 32-34 rejected under 35 U.S.C. 102(e) as being anticipated by Burnett (U.S. Patent Application Publication No. 2002/0087408).

6. Claims 1-6, 12-17 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Burnett (U.S. Patent Application Publication No. 2002/0087408).

As to claims 1, Burnett teaches a method for providing automatically facilitated marketing and provision of electronic services (See abstract; paragraphs 0001-0002; paragraph 0036-0043), comprising:

searching a database for a match between user input and information in the database (See paragraph 0015; paragraph 0029; paragraph 0087);

obtaining keywords resulting from the searching step (See paragraphs 0015-0017; paragraph 0019);

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determine at least one offered service associated with the at least one keyword, the at least one offered service associated with a technical weighting indicating a technical relevance of the at least one offered service and a preference weighting indicating a provider preference of the at least one offered service (See paragraphs 0015-0017; paragraph 0019; paragraphs 0352-0353; paragraph 0364);

determine a weighted value associated with the at least one offered service based on the associated technical weighting and the associated preference weighting (See paragraphs 0015-0017; paragraph 0162; paragraphs 0352-0353; paragraph 0364), and

prioritize the at least one offered service based on the determined weighted value customer (See abstract; paragraphs 0001-0002; paragraph 0035; paragraph 0039; paragraphs 0042-0043; paragraph 0052).

As to claim 2 and 14, Burnett teaches wherein determining at least one offered service associated with the at least one keyword further comprises: determining at least one generic service related to the at least one keyword (See paragraphs 0036-0039); and determining the at least one offered service based on the at least one generic service (See Burnett, paragraphs 0015-0019; paragraph 0094; paragraph 0264; paragraph 00353; paragraph 0364).

As to claims 3, 15 and 33, Burnett teaches if the at least one offered service includes a bundle of two or more services, then determining a weighted

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value associated with the at least one offered service based on a technical weighting and a preference weighting associated with each of the two or more services of the bundle of service (See Burnett, paragraph 00353; paragraph 0364).

As to claims 12 and 22, Burnett, teaches outputting the at least one offered service and information associated with the at least one offered service to a user's processing device (See Burnett, paragraph 00015; paragraph 00017; paragraph 0162; paragraph 0364).

As to claim 13, Burnett teaches a computer-readable medium (See abstract; paragraphs 0001-0002; paragraph 0036-0043) comprising:

searching a database for a match between user input and information in the database (See paragraph 0015; paragraph 0029; paragraph 0087);

logic configured to obtain at least one keyword resulting from the search (See paragraphs 0015-0017; paragraph 0019);

logic configured to determine at least one offered service associated with the at least one keyword, the at least one offered service associated with a technical weighting indicating a technical relevance of the at least one offered service and a preference weighting indicating a provider preference of the at least one offered service (See paragraphs 0015-0017; paragraph 0019);

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logic configured to determine a weighted value associated with the at least one offered service based on the associated technical weighting and the associated preference weighting (See paragraphs 0352-0353); and

logic configured to prioritize the at least one offered service based on the determined weighted value (See abstract; paragraphs 0001-0002; paragraph 0035; paragraph 0039; paragraphs 0042-0043; paragraph 0052).

As to claim 24, Burnett teaches a system for automatically facilitated marketing and provision of electronic security services (See Burnett, abstract; paragraphs 0001-0002; paragraph 0036-0043), comprising:

a service suggestion analyzer operatively coupled to the cycler, the service (See Burnett, abstract; paragraphs 0001-0002; paragraph 0035; paragraph 0039; paragraphs 0042-0043; paragraph 0052).

determine at least one offered service associated with the at least one keyword, the at least one offered service associated with a technical weighting indicating a technical relevance of the at least one offered service and a preference weighting indicating a provider preference of the at least one offered service (See paragraphs 0015-0017; paragraph 0019; paragraphs 0352-0353; paragraph 0364);

determine a weighted value associated with the at least one offered service based on the associated technical weighting and the associated preference weighting (See paragraphs 0015-0017; paragraph 0162; paragraphs 0352-0353; paragraph 0364), and



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prioritize the at least one offered service based on the determined weighted value customer (See abstract; paragraphs 0001-0002; paragraph 0035; paragraph 0039; paragraphs 0042-0043; paragraph 0052).

As to claim 25, Burnett as modified, teaches wherein the service suggestion analyzer further comprises an analyzer module, a service module and an output module (See Burnett, paragraph 0036-0043).

As to claim 26, Burnett as modified, teaches wherein the service suggestion analyzer comprises a psychological assistant module and a special deals interface module configured to provide special sales on time sensitive offers (See Burnett, paragraphs 0211; paragraphs 252-253; paragraph 266; paragraphs 277-278; paragraph 369; paragraph 412-413).

As to claim 27, Burnett as modified, teaches wherein the service suggestion analyzer is further configured to: determining at least one offered service associated with the at least one keyword further comprises: determining at least one generic service related to the at least one keyword (See paragraphs 0036-0039); and determining the at least one offered service based on the at least one generic service (See Burnett, paragraphs 0015-0019; paragraph 0094; paragraph 0264; paragraph 00353; paragraph 0364).

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As to claim 28, Burnett as modified, teaches wherein the analyzer module is further configured to include a lookup table to provide the clustered needs list (See Burnett, paragraph 0173; paragraph 0176; paragraph 0183; paragraph 0186; paragraph 0188; paragraph 0194).

As to claim 32, Burnett as modified, teaches wherein the output module is operatively coupled to the service module and the output module is further configured to provide at least one offered service to a user via at least one of a user's display device of a processing device, auditory means including synthesized voice or paging device (See Burnett, paragraph 00015; paragraph 00017; paragraph 0162; paragraph 00353; paragraph 0364).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7, 9-11, 18-21, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burnett (U.S. Patent Application Publication No. 2002/0087408, in view of Williams et al. (U.S. Patent No. 5,977,964), in view of Lawrence et al. (U.S. Patent No. 6,738,780).

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As to claims 7, 18, and 29, Burnett does not teach calculating maximum and minimum thresholds; and comparing the maximum and minimum thresholds to a ratio of the associated technical weighting and the associated preference weighting to determine if the associated preference weighting is overriding the associated technical weighting.

Lawrence et al. teaches autonomous citation indexing and literature browsing using citation context (See abstract), in which he teaches calculating maximum and minimum thresholds (See column 12, lines 49-67; column 13, lines 1-10; column 14, lines 35-48); and comparing the maximum and minimum thresholds to a ratio of the associated technical weighting and the associated preference weighting to determine if the associated preference weighting is overriding the associated technical weighting (See paragraphs 0352-0353).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to have modified Burnett, to include calculating maximum and minimum thresholds; and comparing the maximum and minimum thresholds to a ratio of the associated technical weighting and the associated preference weighting to determine if the associated preference weighting is overriding the associated technical weighting.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Burnett, by the teachings of Lawrence et al. because calculating maximum and minimum thresholds; and comparing the maximum and minimum thresholds to a ratio of the associated technical weighting and the associated preference weighting to determine if the

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associated preference weighting is overriding the associated technical weighting would improve the method for finding relevant and important publications on the web (See Lawrence et al., column 1, lines 61-66).

As to claims 9, 19, and 30, Burnett as modified, teaches adjusting or reducing the weighted summation value associated with the at least one offered service if the ratio of the associated technical weighting and the associated preference weighting violates the maximum threshold or the minimum threshold (See Lawrence et al., column 12, lines 49-67; column 13, lines 1-10; column 14, lines 35-48).

As to claims 10, 20, and 31, Burnett as modified, teaches discarding the at least one offered service if the ratio of the associated technical weighting and the associated preference weighting violates the maximum threshold or the minimum threshold (See Lawrence et al., column 12, lines 49-67; column 13, lines 1-10; column 14, lines 35-48).

As to claims 11 and 21, Burnett as modified, if the at least one offered service includes a bundle of two or more services calculating a comparison value for the at least one offered service by adjusting the weighted value associated with the at least one offered service (See Burnett, paragraph 00015; paragraph 00017; paragraph 0162; paragraph 00353; paragraph 0364; also see Lawrence et al., column 12, lines 49-67; column 13, lines 1-10; column 14, lines 35-48).

***Response to Arguments***

9. Applicant's arguments filed on March 5, 2007, with respect to the rejected claims 1-3, 7, 9-15, 18-22, and 24-33 have been fully considered but they are not found to be persuasive:

In response to applicants' arguments regarding *"Burnett does not teach, suggest, or describe a method for providing automatically facilitated marketing and provision of electronic services as recited by claim 1,"* the arguments have been fully considered but are not found to be persuasive, because the argument is moot because the claims do not contain such language.

In response to applicants' arguments regarding *"Burnett fails to teach, suggest, or describe that at least one of the database records is associated with a technical weighting indicating a technical relevance of the at least one database record and a preference weighting indicating a provider preference of the at least one database record. Moreover, Burnett fails to teach, suggest, or describe determining a weighted value associated with the at least one database record based on the associated technical weighting and the associated preference weighting and prioritizing the at least one database record based on the determined weighted value,"* the arguments have been fully considered but are not found to be persuasive, because Burnett discloses words that have identifiers and that are weighted and determined to be outputted to the user in a prioritized manner (See paragraphs 0352-0353).

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Any inquiry concerning this communication should be directed to Mellissa M. Chojnacki  
at (571) 272-4076.



**SAM RIMELL**  
**PRIMARY EXAMINER**

Mellissa M. Chojnacki  
Art Unit 2164